UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,486	07/21/2003	Pierre Garnier	235812US26CONT	4972

22850 7590 04/12/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
HUGHES, ALICIA R	
ART UNIT	PAPER NUMBER
1614	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/12/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/12/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/622,486	GARNIER, PIERRE	
	Examiner	Art Unit	
	Alicia R. Hughes	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *20 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *54-61 and 63* is/are pending in the application.

4a) Of the above claim(s) *62* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *54-61 and 63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/270,319.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *(5 pages)*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 54-64 are pending and the subject of this Office Action. Applicant cancelled claims 1-53 in an action filed on 21 July 2003.

Restriction Requirement

Applicant's election of species, in the reply filed on 20 February 2007 is acknowledged. Claim 62 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species. Because applicant did not distinctly and specifically point out that his election is with traverse, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 U.S.C. §112.2

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 54-64 are rejected under 35 U.S.C. §112, second paragraph for indefiniteness. The phraseology "means" in claim 54 is relative and therefore, renders the claim indefinite. The phraseology "means" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Applicant may consider amending claim 15 in a way that is explicit, thereby more clearly defining the invention. For example, Applicant should draft the

language in such a way that one of ordinary skill in the art would read the claim and be able to ascertain whether Applicant is referring to a legend or standard for evaluating the product.

Claims 56, 58, 59, 61, 62, and 64 are rejected under 35 U.S.C. §112, second paragraph for indefiniteness. The phraseology "comprises" as utilized in these claims makes the invention contained in the claims ambiguous and the actual limitations of the invention, hard to ascertain. Examiner suggests Applicant consider substituting "comprising" for language more carefully worded along the lines of "consisting essentially of," for example.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 54-61 and 62-63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 54-57 of U.S. Patent Application No. 10,622,825. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they contain identical subject matter and both relate to a product or care system/kit comprising an anti-wrinkle product and a test device to determine the product's efficacy. For example, both applications involve (1) a transparent substrate; (2) an adhesive that is a solid; (3) a treatment product that is an anti-wrinkle agent; and (4) a visualizing substrate having a darkening area.

Claim Rejections – 35 U.S.C. §103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 54-58 and 60 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,968,533 [hereinafter referred to as "Porter et al"] in view of U.S. Patent No. 6,174,536 [hereinafter referred to as "Crotty et al"].

Porter et al teach a solid state (Col. 4, lines 66-67) dermal delivery device adhered to the skin using a pressure-sensitive adhesive for treatment of skin wrinkles (Col. 12, lines 45-46, claim 9; col. 4, lines 28-30), wherein the device comprises a protective backing substrate (Col. 4, lines 41-58) topped with a pharmaceutical composition matrix, containing a cosmetically active ingredient (Col. 5, lines 13-15), and a release liner contacted on the matrix (Col. 12, lines 45-55, claim 9; col. 4, line 36-40).

Porter et al also teach that the device is configured in such as way that the "cosmetically active ingredients ... [are] located between the backing material and the adhesive, and during use, formulation ingredients pass through the adhesive and then into the skin" (Col. 5, lines 1-8) and that a "thin, flexible occlusive film[] serve[s] as protective backing substrate and release liner (Col. 4, lines 41-58).

Crotty et al teach a cosmetic product for the removal of keratotic plugs from the skin which utilizes a test device/strip that when contacted with a certain polymeric composition and a fluid, has adhesive properties, most notably a test strip that once wetted and applied to the skin, adheres to the skin and upon drying, can be pulled away concomitantly, pulling keratotic plugs with it (Col. 7, lines 1-16; Col. 8, lines 1-15). Crotty et al also teach a method of evaluating the efficacy of the test strips, wherein the number of pores are counted and thereafter, "[w]ater was applied to the patch and it was then placed over the test area with wet side down. Next the patch was allowed to dry whereupon it was peeled off. The number of plugs removed were counted as

they appeared on the adhesive patch," and the percentage of plugs removed were calculated to determine the efficacy of the product (Col. 5, lines 1-67).

One of ordinary skill in the art would be motivated to combine the teachings of Porter et al with the teachings of Crotty et al., because the references teach overlapping subject matter, most notably, cosmetic or care products for the skin using adhesive test devices.

In light of the foregoing, when used together, it would have been *prima facie* obvious to one of ordinary skill to utilize a test device to determine the efficacy of a skin care or cosmetic product to treat wrinkles and other signs of aging.

Claims 54 and 61 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,968,533 [hereinafter referred to as "Porter et al"] in view of U.S. Patent No. 6,174,536 [hereinafter referred to as "Crotty et al"] and in further view of U.S. Patent No. 5,935,596 [hereinafter referred to as "Crotty et al II"].

The teachings of Porter et al and Crotty et al, *infra*, are incorporated herein by reference.

Crotty et al II teach a cosmetic composition/care product with "formulated onto a flexible substract sheet impregnated with an adhesive composition ...[t]he impregnated substrate sheet is sealably enclosed in a pouch ..."(Col. 5, lines 45-63; col. 11, lines 37-45; col. 12, lines 18-26).

One of ordinary skill in the art would be motivated to combine the teachings of Porter et al and Crotty et al with the teachings of Crotty et al II, because the references teach overlapping subject matter, most notably, cosmetic or care products for the skin using adhesive test devices.

In light of the foregoing, when used together, it would have been *prima facie* obvious to one of ordinary skill to utilize a test device to determine the efficacy of a skin care or cosmetic

product to treat wrinkles and other signs of aging and that the product and test device could be packaged together.

Claims 54, 59, 60 and 63 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,968,533 [hereinafter referred to as "Porter et al"] in view of U.S. Patent No. 6,174,536 [hereinafter referred to as "Crotty et al"] and in further view of U.S. Patent No. 5,723,138 [hereinafter referred to as "Bae et al"].

The teachings of Porter et al and Crotty et al, *infra*, are incorporated herein by reference.

In addition to the teachings of Porter et al and Crotty et al, Bae et al teach an adhesive cosmetic product and method of applying the same "followed by adhering the adhesive film [to] exhibit [the] prominent effect of removing the furrows or wrinkles" considered to be an improvement over conventional cosmetic compositions for removing the same (Abstract, para. 2; Col. 4, lines 24-34). Bae et al also teach that "[t]he excellent effect of the adhesive type cosmetic product as compared to those cosmetics of applying type is due to the effect of the adhesive tape itself which induces continuous penetration of the active ingredients and protects the ingredients and protects the ingredients and physically stretches the skin ..." (Col. 4, lines 35-40).

Bae et al goes on further to provide examples of the development of the adhesive type cosmetic products, including coating the cosmetic composition onto a "transparent polymeric film ... and then a releasing paper was covered thereon" and then, the affixation of the device to the skin (Col. 5, lines 9-67). And finally, Bae et al provides experimental data to support how the invention yields the removal of wrinkles (Col. 6, lines 23-57), the removal of deep furrows (Col. 6, lines 62-67), and is sensitive to the topography of the skin (Col. 7, lines 16-42).

One of ordinary skill in the art would be motivated to combine the teachings of Porter et al and Crotty et al with the teachings of Bae et al., because the references teach overlapping subject matter, most notably, the skin cosmetics to reduce the appearance of aging signs, notably wrinkles.

One of ordinary skill in the art would be motivated to apply the teachings of Porter et al, Crotty et al, and Bae et al to the present invention, because an adhesive cosmetic product with transparent polyemeric films that are sensitive to the topography of the skin are an excellent improvement over more conventional skin treatments that would combine the signs of aging . In light of the foregoing, when used together, it would have been *prima facie* obvious to one of ordinary skill in the art to create a cosmetic or care product system comprising a skin care product and a test device with a transparent polymeric film adhesive sensitive to the skin in order to determine the efficacy of the product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Hughes whose telephone number is 571-272-6026. The examiner can normally be reached from 9:00 A.M. until 5:00 P.M. on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax number for the organization where this application is proceeding is assigned 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

27 March 2007
ARH

BRIAN-YONG S. KWO
PRIMARY EXAMINER